

REMARKS

In the Action, claims 1, 2 and 6 are rejected, and claims 3-5 are withdrawn from consideration as being directed to the non-elected invention. In response, claims 1, 2 and 6 are amended, and new claims 7-11 are added. Independent claims 1 and 2 are amended to recite a tyrosinase inhibitor composition containing the compound of Formula 1. Claim 6 is amended to recite a process for preparing the agent to overcome the rejection under 35 U.S.C. § 112, second paragraph. New claims 7-10 are added to depend from claims 1 and 2 and to recite the process for skin lightening, combating age spots and inhibiting browning of foods using the compositions of claims 1 and 2. These claims are supported by the specification and claims as originally filed.

New claim 11 depends from claim 1 and recites the composition further including at least one compound selected from the group consisting of a fragrance, a compound for the care and/or cleansing of skin and/or hair, and a UV absorbing agent. Claim 11 is supported by the specification and effectively links claims 3-5 with claim 1. Thus, claim 11 is a linking claim to overcome the restriction. Applicants respectfully submit that claims 3-5 should be rejoined with claim 1.

In view of these amendments and the following comments, reconsideration and allowance are requested.

Obviousness-Type Double Patenting

Claims 1, 2 and 6 are provisionally rejected for obviousness-type double patenting over copending application Serial No. 12/159,886, Serial No. 12/159,866 and Serial No. 12/159,951. Applicants respectfully submit that the obviousness-type double patenting rejections are improper and should be withdrawn. Copending application Serial No. 12/159,886 and Serial No.

12/159,951 are directed to preparations that contain various components in addition to the tyrosinase inhibitor. In the present application, the Examiner based the restriction of claims 3-5 on the position that they contain an additional component, and thus, are distinct inventions. Thus, Applicants' respectfully submit that the Examiner is taking an inconsistent position with respect to the additional component. The Examiner cannot assert that an additional component is a distinct invention for purposes of restriction practice and then contend the components are obvious to support an obviousness-type double patenting rejection. Accordingly, the obviousness-type double patenting rejections are improper and should be withdrawn.

Rejection of Claims 1 and 6

Claims 1 and 6 are rejected under 35 U.S.C. § 102(b) over the publication by Yamamura et al. as evidenced by WO 00/56279 to Collington. Yamamura et al. is directed to a study of the antioxidant activities of various dihydric phenol derivatives and particularly to the autoxidation of tetralin. Yamamura et al. is not concerned with a tyrosinase inhibitor composition and does not disclose or suggest a topical composition containing the compound of Formula 1 or styrylresorcinol in an amount effective for lightening skin and combating age spots. Accordingly, Yamamura et al. does not anticipate the claims.

Collington does not provide the deficiencies of Yamamura et al. Collington discloses resorcinol as a skin lighting agent but does not suggest the claimed compounds. Collington provides no suggestion to one skilled in the art that the claimed compounds are effective in skin lightening or that the compounds of Yamamura et al. can be used as a skin lightening composition. One skilled in the art in reviewing Collington would have no reasonable

expectation of success in promoting skin lightening using the compounds of Yamamura et al. based on the disclosure of Collington or Yamamura et al.

In view of the deficiencies of Yamamura et al. and Collington, claims 1 and 6 are not anticipated by Yamamura et al. either alone or taken with Collington.

Claims 1, 2 and 6 are rejected under 35 U.S.C. § 103 as being obvious over JP 11-255637 to Kondo et al. in view of Yamamura et al.

Kondo et al. is directed to cosmetics that include specifically defined compounds as a tyrosinase inhibitor. The Action refers to compound 1 of Formula 2 on page 2 of the translation. Kondo et al. is directed to a limited number of compounds having a specific structure. Claim 1 as amended is distinguishable from compound 1 of Kondo et al. In view of the limited number of compounds described by Kondo et al., it would not have been obvious to one of ordinary skill in the art to modify Kondo et al. to attain the claimed composition including a tyrosinase inhibitor of Formula 1 as recited in claim 1. Kondo et al. provides no suggestion to one skilled in the art and provide no reasonable expectation that the compounds of Formula 1 as claimed would exhibit tyrosinase inhibiting activity.

Yamamura et al. as noted above has no relation to a tyrosinase inhibitor composition. The broad disclosure of various antioxidant compounds of Yamamura et al. provides no suggestion to one skilled in the art to modify the specifically defined compounds of Kondo et al. Moreover, Yamamura et al. does not provide one of ordinary skill in the art with a reasonable expectation that the claimed compounds exhibit tyrosinase inhibitor activity. Accordingly, the claimed composition as amended is not obvious over the combination of Kondo et al. and Yamamura et al.

Kondo et al. clearly does not disclose the tyrosinase inhibitor composition including styrylresorcinol as in claim 2. For the reasons discussed above, Yamamura et al. provides no suggestion or expectation of success in using styrylresorcinol in a tyrosinase inhibitor composition. Accordingly, claim 2 is not obvious over the combination of the cited patents.

Kondo et al. and Yamamura et al. also do not suggest a process for preparing an agent for the treatment against skin and hair browning or combating age spots or inhibiting browning of foods using the compound of Formula 1. Kondo et al. and Yamamura et al. provide no suggestion to one skilled in the art to produce an agent for the treatment as recited in claim 1 using the compounds of Formula 1. Furthermore, Kondo et al. and Yamamura et al. provide no reasonable expectation of success in producing a formulation or agent effective for treatment against skin and hair browning, combating age spots and inhibiting browning of foods as recited in claim 6.

In view of these amendments and the above comments, the claims are submitted as being allowable over the art of record. Accordingly, reconsideration and allowance are requested.

Respectfully submitted,



Garrett V. Davis
Reg. No. 32,023

Roylance, Abrams, Berdo & Goodman, L.L.P.
1300 19th Street, N.W., Suite 600
Washington, D.C. 20036-1649
(202) 659-9076

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